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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,087	09/12/2005	Ning-Ping Chan	QNAT0001P	1993

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EXAMINER

YEN, ERIC L

ART UNIT	PAPER NUMBER
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2626

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02/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,087	Applicant(s) CHAN, NING-PING	
	Examiner ERIC YEN	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 15, 32, 42 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 15, 32, 42, 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the Office Action mailed 7/8/09, applicant has submitted an amendment filed 10/8/09.

Claims 8, 15, 32, 42, and 49, have been amended. Claims 1 and 22 have been cancelled.

Response to Arguments

1. Applicant's arguments with respect to claims 8, 15, 32, 42, and 49, have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that "adjusting the size of the bubble and tail of the bubble" is supported by Figure 2 of the provisional application. However, Figure 2 only shows that there is a bubble and a tail. It says nothing about adjusting the size of the bubble and tail of the bubble. It is not necessarily the case that just because the bubble and tail in the image of Figure 2 fit without interfering with other text that the sizes were adjusted. It is just as easily the case that the bubble is constantly that size, and happened to fit the image in the depicted scenario in Figure 2. Also, the tail does not necessarily "approximately overlap with the pointer" since no pointer is depicted. Therefore, this limitation does not have benefit the 9/30/02 priority date of the provisional application. The submitted affidavit also does not show anything more than the provisional

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application and therefore the "adjusting" limitation does not have benefit to the 6/2002 priority date claimed by applicant.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

"Computer usable medium" is not a term defined in the Specification, and so is, under current office policy, interpreted as including carrier waves and other signal media that are non-statutory. An amendment to recite "non-transitory" computer readable medium is required to resolve the issue.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8, 15, 32, 42, 49, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 42 is directed to a system claim defined by a series of method steps. Under IXPL Holdings v Amazon, 430 F.3d 1377, “reciting both an apparatus and a method of using that apparatus renders a claim indefinite under section 112”. System claims are directed to what the system is, and therefore all method steps are functional language that does not have patentable weight. Therefore, the scope of Claim 42 which has patentable weight is only a system with a client application and a server.

Similarly, Claim 8 recites “a computer usable medium containing instructions in computer readable form for carrying out a process for providing a user with bilingual annotation on a piece of textual annotation... said process consisting of the following steps”. Since the steps themselves don’t define what the computer readable medium or what the instructions are, they are, similarly given no patentable weight and are indefinite for the same reasons as Claim 42.

As per Claim 15, the claim recites “consisting of the following steps” and also includes “wherein clauses” that are merely descriptive. If the steps are, as applicant argues, exclusive of all other steps, then there is a contradiction because the wherein clauses state that there was an adjustment step and a dynamic association which are directly related to the primary purpose of the method described in the preamble, and the “consisting of” language by definition excludes these steps. Therefore, the scope of the claim is not clear.

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Claims 32 and 49 have the same issue as claim 15, where there are method steps being claimed in a closed system with descriptive "wherein" clauses that necessitate other steps that were by definition excluded by the claim language "consisting of".

Claim 32 also recites a "graphical user interface comprising: means for activation or deactivation of said application", and "means for selecting said second language from a list of languages". This is indefinite because 112-6th "means for"/"step for" language is directed to actual components or method steps, respectively. The activation/deactivation of said application and selecting said second language are components, and so using "means for" to describe the claim limitations is indefinite.

5. Claims 8, 15, 32, 42, 49 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

Method Claims 15, 32, and 49 (and, if applicant intends to amend system and computer readable medium claims 8 and 42 to include similar limitations defining what the computer readable medium and system is), lack steps necessary to complete other recited method steps.

For example, the "screen-scraping a segment of text adjacent to, or overlaid by, the user's pointer" necessarily requires determining where the user's pointer is. If the claims are limited to "consisting of" the listed steps, then all other accompanying steps

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necessary to accomplish those steps must be included in the claims. Also, if there is no "other reading aid information" obtained at any point, then it cannot be included in the callout. Since these steps, among others, are by definition excluded from the claim scope due to the language "consisting of". Furthermore, the adjusting and associating steps suggested/implied in the "wherein clauses" are also omitted by definition.

Generally, since applicant has amended the claim language to recite "consisting of", it is not clear whether certain essential steps are excluded and also which steps are included. Therefore, Claims 8, 15, 32, 42, and 49, are rejected as being vague and indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 8 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Proszeky ("An Intelligent Multi-Dictionary Environment").

As per Claim 8, Proszeky teaches a computer usable medium containing instructions in computer readable form for carrying out a process for providing a user with bilingual annotation on a piece of textual information in a first language contained in

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an electronic document displayed in the user's screen (Figures 1-4; where Figure 3 shows a bilingual annotation including grapes and greips [two languages] on the word "grapes" and the displayed screen is an electronic document. As discussed above, the process is part of an intended use limitation and therefore the steps in the process, which do not define what the computer usable medium is, does not have patentable weight).

As per Claim 42, Proszeky teaches a system for providing real-time multilingual annotation service over a global network from a server to a user (Figures 1-4; "system has a TCP/IP-based client-server implementation for various platforms", Abstract; where TCP/IP interactions is a global network [IP is internet protocol including the world wide global web])

Said system consisting of:

A client application which runs on the user's computer ("TCP/IP-based client", Abstract)

A server application which runs on the server ("client-server", Abstract; as discussed above, method steps in system/apparatus claims do not define what a system/apparatus is and therefore is only intended use that is not given patentable weight).

Allowable Subject Matter

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not teach the combination of only those method steps in the claims, which excludes the other steps necessary to perform those steps listed in the claims (e.g., the wherein clauses and also the missing determination of where the user's pointer is).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ito (US 6,330,529).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC YEN whose telephone number is (571)272-4249. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on 571-272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EY 1/29/10

/Richemond Dorvil/
Supervisory Patent Examiner, Art Unit 2626